

REMARKS

I. Introduction

With the addition of new claim 15, claims 8 to 15 are pending in the present application. In view of the foregoing amendments and the following remarks, it is respectfully submitted that all of the presently pending claims are allowable, and reconsideration is respectfully requested.

II. Rejection of Claims 8 to 14 Under 35 U.S.C. § 103(a)

Claims 8 to 14 were rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of U.S. Patent No. 6,039,271 ("Reiter") and U.S. Patent No. 6,405,946 ("Harata et al."). It is respectfully submitted that the combination of Reiter and Harata et al. does not render unpatentable the present claims for at least the following reasons.

Claim 8 relates to a method for producing and securing an apertured disk for a fuel injector for a fuel-injection system of an internal combustion engine, the apertured disk having an opening contour which ensures a complete passage of a fluid, the method including: a) providing a flat, metallic sheet having a constant thickness; b) reducing a thickness in one region of the sheet by one of impressing and embossing; c) introducing at least one spray-discharge opening in the region having reduced thickness; d) machining the sheet until an apertured disk having predefined outside dimensions is attained; and e) securing the apertured disk on a valve-seat member of the fuel injector in such a way that a lower end face of the valve-seat member delimits, along with the reduced-thickness region, an intake region of the apertured disk, and a vertical projection of the lower end face of the valve seat member onto an upper surface of the reduced-thickness region completely overlaps the at least one spray-discharge opening.

Although Applicants may not agree with the merits of the rejection, to facilitate matters, claim 8 has been amended without prejudice to recite, that the introducing is performed after the reducing and that the machining is performed after the introducing. Thus, claim 8 recites in relevant part that a method includes "c) after the reducing, introducing at least one spray-discharge opening in the region having reduced thickness" and "d) after the introducing, machining the sheet until an apertured disk having predefined outside dimensions is attained." Support for these

amendments may be found, for example, page 6, line 28 to page 7, line 2 of the Specification.

As admitted on page 2 of the Office Action, Reiter does not disclose a material thickness reduction, and as admitted on page 3 of the Office Action, with reference to Harata et al., “[i]t is not known if the depression is formed by embossing or impressing.” The Office Action’s statement that “he [sic] patentability of a product does not depend on its method of production” is not understood -- and is, indeed, entirely irrelevant -- in the present context, since all of the present claims are method claims. As the Office Action admits that the combination of Reiter and Harata et al. does not disclose all of the features included in claim 8, it is respectfully submitted that the combination of Reiter and Harata et al. does not render unpatentable claim 8.

Moreover, the statement that “it is known to reduce thickness by all forms of stamping and embossing, as both are known to have and [sic] affect [sic] on material by their implicit nature, and would further be desirable in order to provide a part with a desired thickness tolerance in order to ensure proper filling into its designated placement within an apparatus,” to the extent that it is understandable, does not detract from the admitted failure of the combination of Reiter and Harata et al. to disclose all of the features included in claim 8. If maintained, support for this otherwise unsupported statement is respectfully requested.

The statement that “the act of machining the sheet until an apertured disk has predefined outside dimensions attained is a known technique to one of ordinary skill and does not hold any patentable weight as it is used universally in the fuel injector art” is neither understood nor tenable, to the extent it is understandable. In any event, this unsupported contention does not detract from the critical deficiencies noted above with respect to the combination of Reiter and Harata et al. If maintained, support for this otherwise unsupported statement is respectfully requested.

In view of all of the foregoing, it is respectfully submitted that the combination of Reiter and Harata et al. does not render unpatentable claim 8.

As for claims 9 to 14, which depend from claim 8 and therefore include all of the features of claim 8, it is respectfully submitted that the combination of Reiter and Harata et al. does not render these dependent claims unpatentable for at least the reasons set forth above in support of the patentability of claim 8.

In view of all of the foregoing, withdrawal of this rejection is respectfully requested.

III. New Claim 15

New claim 15 has been added herein. It is respectfully submitted that claim 15 adds no new matter and is fully supported by the present application, including the Specification. Since claim 15 depends from claim 8, it is respectfully submitted that claim 15 is patentable over the references relied upon for at least the reasons more fully set forth above in support of the patentability of claim 8.

IV. Conclusion

In light of the foregoing, Applicants respectfully submit that all pending claims are in condition for allowance. Prompt reconsideration and allowance of the present application are therefore earnestly solicited.

Respectfully submitted,

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